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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,651	12/01/2000	Paul E. Jacobs	PA000383	5961
23696	7590	10/12/2004	EXAMINER	
Qualcomm Incorporated Patents Department 5775 Morehouse Drive San Diego, CA 92121-1714			ALVAREZ, RAQUEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,651

Applicant(s)

JACOBS ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/4/04, 7/15/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 7/15/2004.
2. Applicant has elected invention I, consisting of claims 1-31.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40, 111-113, 126-127, 136-137 and 146 of copending Application No.09/679,039. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites transmitting ad-statistical data. Calculating and transmitting statistical data it is old and well known in business in order to calculate and transmit statistical data in order to make educated assumptions and statements on a particular subject. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

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4. Claims 1-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No.09/679,038. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application further recites an ad link history display window that lists links to the sources of advertisements that the user has previously visited. Listing the sources of advertisements or information that the user has previously visited it is old and well known in order to keep track of the success of the different sources of advertisements. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have included a display window that lists links to the sources of advertisements that the user has previously visited in order to achieve the above mentioned advantage.

5. Claims 1-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No.09/728,693. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application further recites that the advertisement download communication link and the data communication link are separate communication links. It is old and well known in the communication and networking arts to have various communication links because such a modification would allow for easier transmission of data. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have link are separate communication links in order to achieve the above mentioned advantage.

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6. Claims 1-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 and 51-53 of copending Application No.09/668,553. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites transmitting ad obscured ad monitor function that determines whether an obscured ad condition has occurred, whereby the obscured ad condition occurs when an advertisement current being displayed on the display associated with the client device is being obscured by one or more other items currently being displayed on the display and an obscured nag function that generates an obscured ad nag display in response to detection of the obscured ad condition, wherein the obscured nag display notifies the user of the obscured ad condition. Since, monitoring and displaying various advertisements which can occupy the entire portion of the display along with banner advertisements is obvious in on-line advertisements then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included detecting if a displayed advertisement such as a banner advertisements is being obscured by an advertisement and notifying the user in order for the user to be aware that might not be compensated for viewing the banner advertisements that is being obscured by the advertisement.

7. Claims 1-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-33, 59 and 62 of copending Application No.09/668,331. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending

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application further recites a playlist that identifies the advertisements to be downloaded. Identifying or selecting the advertisements to be downloaded is obvious and well known in order to provide some sort of order within the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

8. Claims 1-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-70, 74-76 and 78 of copending Application No.09/668,515. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application further recites three operating modes. Different operating modes such as Online and offline operating modes are known in the computer related arts in order to provide different states of the program. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving and sending e-mail messages in order to achieve the above mentioned advantage.

9. Claims 1-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,9-11,14-24,43,45-54,77-79,81,82,84,86-92,94,95,97-105,107-109 and 111 of copending Application No.09/668,631. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending application further recites a playlist that identifies the advertisements to be downloaded. Identifying or selecting the advertisements to be downloaded is obvious and well known in order to

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provide some sort of order within the system. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

10. Claims 1-31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-53 of copending Application No.09/668,600. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites a third operating mode in which the software switches the operating from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode. Official notice is taken that it is old and well known in the computer related arts to switch from one operating mode to another operating mode that has less features when a problem arises with one of the operating mode because such a modification would allow the software to operate with less features and in that case less problems are less likely to occur. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included switching from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode in order to obtain the above mentioned advantage.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claims 1, 2-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Marsh et al. (5,848,397 hereinafter Marsh).

With respect to claims 1-2, 6-7, 9-12 Marsh teaches a system for distributing advertisements to a multiplicity of client devices each of which is configured for communications via a communication network (Abstract). An advertisement distribution facility that communicates with each of the client devices over the communication network (Figure 8); wherein each of the client devices downloads advertisements from the advertisement distribution facility, and displays at least ones of the downloaded advertisements (Figures 4-5); wherein the advertisement distribution facility includes a auditing function that transmits send audit data request to a subset of the client devices at the prescribed client audit intervals (col. 14, lines 66-, col. 15, lines 1-7); wherein the send audit data request includes a request that the receiving client device transmit ad-related statistical data to the advertisement distribution facility (col. 14 lines 66 to col. 15 lines 1-20 and Figure 8, teaches that the statistics log file is stored in storage 101 and that is sent to sever system 104, which uses the statistics to determine which advertisements to subsequently present to the user).

With respect to claims 4-5, Marsh further teaches under a client policy transmitting a statistical sampling of a population of client devices, at prescribed times (col. 3, lines 12-27 and col. 7, lines 7-24).

With respect to claim 8, Marsh further teaches clickthrough data regarding each advertisement that was clicked on by the user during the prescribed audit interval (col. 15, lines 14-20).

With respect to claim 14 , Marsh further teaches that at least one of the server is managed by a vendor of software installed on the client device (col. 3, lines 12-56).

With respect to claim 15, Marsh teaches that at least one of the ads servers is managed by an entity other than the producer of the software installed on each client device (Figure 8).

With respect to claims 13 and 16, Marsh further teaches that the advertisement distribution server system is managed by a producer of the software installed on the client devices (col. 3, lines 12-56).

With respect to claims 17-18, Marsh further teaches at least one ad server that stores the advertisements to be distributed to the client devices, each advertisement being stored in a storage location designated by a source address (Figure 8); at least one playlist server that receives the playlist request from each of the client devices, and that transmits a playlist response in response to each playlist request (Figure 8 and col. 15, lines 10-20); and wherein the playlist response transmitted to each client device

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included at least one playlist that identifies advertisements to be downloaded by that client device (col. 15, lines 1-10).

With respect to claim 19, Marsh further teaches that the communication network is the Internet (Figure 8, 107).

With respect to claim 20, Marsh further teaches that the client devices are equipped with software that effects communications with both the system for distributing advertisements and with data communications service provider (Figure 8).

With respect to claim 21, Marsh further teaches that the software is subsidized by revenues attributable to the downloaded advertisements (col. 3, lines 66-, col. 4, lines 1-6).

With respect to claims 22, 24 and 26, Marsh further teaches that the service provider comprises an e-mail service provider (see Figure 8).

With respect to claims 23 and 27, Marsh further teaches that the service provider comprises an Internet service provider (see Figure 8, 107).

With respect to claim 25, Marsh further teaches that the e-mail software is subsidized by revenues attributable to the downloaded advertisements (col. 3, lines 66-, col. 4, lines 1-6).

With respect to claim 28, Marsh further teaches that the advertisement distribution is operated by a producer of the software installed on the client devices (col. 3, lines 12-56).

With respect to claim 29, Marsh further teaches that at least one of the server is managed by a vendor of software installed on the client device (col. 3, lines 12-56).

With respect to claims 30-31 Marsh further teaches that the software is e-mail software (Figure 8).

Claim Rejections - 35 USC § 103

12. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh in view of Montague (6,298,332 hereinafter Montague).

With respect to claim 3, Marsh teaches sending the statistical data to the server (Figure 8 and col. 14, lines 66-, col. 15, lines 1-20). Marsh does not specifically teach sending the data only in response to a user's grant permission to do so. Montague teaches delivering vendor-supplied information to a purchase, while the purchaser authorizing transmission of various data to a vendor server or a third party server (col. 9, lines 20-24). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Marsh the teaching of

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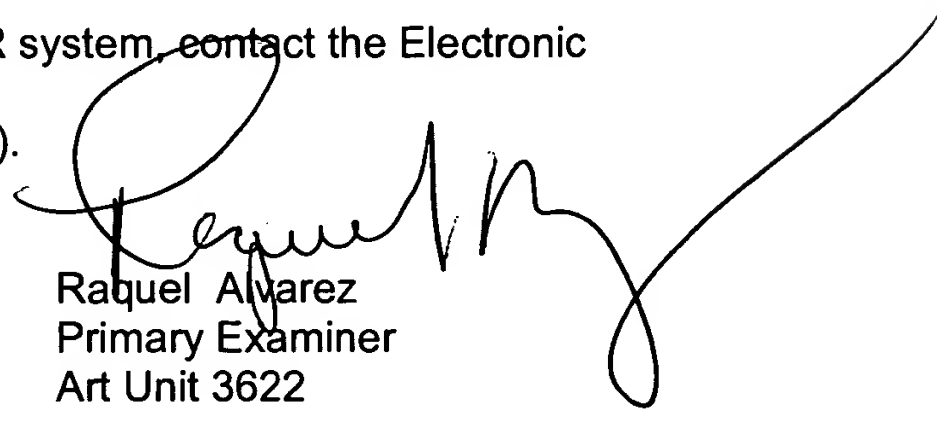
Montague of sending the data only in response to a user's grant permission to do so because such a modification would allow the users to have controlled of the data that is transmitted.

Point of contact

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
10/6/04